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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/044,914	01/15/2002	James Patrick Goodwin	23452-505	4966

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EXAMINER

HIRL, JOSEPH P

ART UNIT	PAPER NUMBER
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2129

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/044,914

Applicant(s)

GOODWIN ET AL.

Examiner

Joseph P. Hirl

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All · b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>A1, A2, A3, A4</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-5 are pending in this application.

Specification

2. The specification @ p 1, 5 and 6 is objected to. Change the specification @ p 1, 5 and 6: delete "Application No., filed January 14, 2002, Attorney Docket No. 23452-500-301," to --Application No. 60/347,283, filed January 14, 2002, --.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 2 rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject

matter under 35 U.S.C. 101. This rejection can be resolved by inserting the term "computerized" prior to the term "method" in the preamble.

5. Claims 4 and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The limitations related to an affinity worker – human - creates uncertainty related to the outcome or lacking concreteness and therefore renders the claim non-statutory.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Karmarkar (U.S. Patent 4,744,028, referred to as Karmarkar).

Claim 1

Karmarkar anticipates a discovery server that creates and maintains a knowledge map representing relationships between system resources (**Karmarkar**, c 1, l 5-11; c 11, l 18-34; c 13, l 44-48; Examiner's Note (EN): para 11 applies; discovery server is the process that dynamically determines cost; knowledge map is the result of the process that determines the cost – a database or data source); a metrics calculator for calculating values representative of the relationships between system resources (**Karmarkar**, c 11, l 18-34; EN: metrics are the cost data) and a data source in

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communication with the discovery server that receives and stores the values from the metrics calculator (**Karmarkar**, c 11, l 18-34; EN: such is the cost register (81)).

Claim 2/3

Karmarkar anticipates determining a raw metric value for a resource that corresponds to a action on or by the resource (**Karmarkar**, c 11, l 54-60; EN: such are the constraint sensors); ranking the raw metric value according to a predetermined scheme (**Karmarkar**, Fig. 4, item 165; EN: steepest decent process will prioritize or rank the raw metric); determining a constant value based, at least in part, upon the ranking of the raw metric (**Karmarkar**, c 7, l 26-30; EN: the new iterate is equal to the current iterate or constant for the next iterate); and calculating a metric value proportional to a product of the raw metric value and the constant value (**Karmarkar**, Fig. 4, item 167).

Claim 4

Karmarkar anticipates a metrics affinity calculator that calculates affinity values for resources (**Karmarkar**, c 11, l 18-34; EN: affinity values are the relationship cost data); a metrics data store that stores the calculated affinity values (**Karmarkar**, c 11, l 18-34; EN: such is the cost register (81)); a metrics affinity worker that communicates with a user mail data store and coordinates generating a message regarding the calculated affinity values according to a predetermined setting (**Karmarkar**, Fig. 4, item 167; EN: para 5 applies).

Claim 5

Karmarkar anticipates calculating affinity values for resources using a metrics affinity calculator (**Karmarkar**, c 11, l 18-34; EN: affinity values are the relationship cost data); storing the calculated affinity values in a metrics data store (**Karmarkar**, c 11, l 18-34; EN: such is the cost register (81)); generating a message regarding the calculated affinity values according to a predetermined setting with a metrics affinity worker that communicates with a user mail data store (**Karmarkar**, Fig. 4, item 167; EN: para 5 applies; predetermined settings relates to the predetermined simplex method).

Examination Considerations

8. The claims and only the claims form the metes and bounds of the invention. "Office personnel are to give the claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d, 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969)" (MPEP p 2100-8, c 2, l 45-48; p 2100-9, c 1, l 1-4). The Examiner has full latitude to interpret each claim in the broadest reasonable sense. Examiner will reference prior art using terminology familiar to one of ordinary skill in the art. Such an approach is broad in concept and can be either explicit or implicit in meaning.

9. Examiner's Notes are provided to assist the applicant to better understand the nature of the prior art, application of such prior art and, as appropriate, to further indicate other prior art that maybe applied in other office actions. Such comments are entirely consistent with the intent and spirit of compact prosecution. However, and unless otherwise stated, the Examiner's Notes are not prior art but a link to prior art that one of ordinary skill in the art would find inherently appropriate.

10. Unless otherwise annotated, Examiner's statements are to be interpreted in reference to that of one of ordinary skill in the art. Statements made in reference to the condition of the disclosure constitute, on the face of it, the basis and such would be obvious to one of ordinary skill in the art, establishing thereby an inherent prima facie statement.

11. Examiner's Opinion: paras 8-10 apply. The Examiner has full latitude to interpret each claim in the broadest reasonable sense.

Conclusion

12. The prior art of record and not relied upon is considered pertinent to applicant's disclosure.

- Makhoulf, U.S. Patent 6,789,054
- Moran et al, U.S. Patent 6,801,940
- Givoly et al, U.S. Patent 6,836,797
- Bruce, U.S. Pub 2002/0049621

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- Nevin, III, U.S. Patent 6,714,936
- Lumelsky et al, U.S. Patent 6,516,350
- Goldberg et al, U.S. Pub 2004/0111386

13. Claims 1-5 are rejected.

Correspondence Information

Any inquiry concerning this information or related to the subject disclosure should be directed to the Examiner, Joseph P. Hirl, whose telephone number is (571) 272-3685. The Examiner can be reached on Monday – Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anthony Knight can be reached at (571) 272-3687.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks,

Washington, D. C. 20231;

Hand delivered to:

Receptionist,

Customer Service Window,

Randolph Building,

401 Dulany Street,

Alexandria, Virginia 22313,

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(located on the first floor of the south side of the Randolph Building);

or faxed to:

(571) 273-8300 (for formal communications intended for entry.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll free).



Joseph P. Hirl
Primary Examiner
July 19, 2005